



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shinji YAMAGUCHI

Group Art Unit: 1764

Application No.: 10/784,303

Examiner: M. MERKLING

Filed: February 24, 2004

Docket No.: 118837

For: CATALYST-CARRIED FILTER, EXHAUST GAS PURIFICATION SYSTEM USING
THE SAME, AND CATALYST BODY

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal and Petition for Extension of Time is attached. Applicant respectfully requests review of the Final Rejection mailed August 23, 2007 in view of the following remarks. Claims 1-4 are pending in this application. Claims 1-4 are rejected.

The Advisory Action indicates that Applicant's arguments, as presented in Applicant's November 23 Response traversing the rejection over U.S. Patent Application Publication No. 2002/0178707 to Vance et al., are persuasive.

This review is requested specifically to address what Applicant believes is an improper construction regarding what WO 00/01463 to Hoj et al. (hereinafter "Hoj") can reasonably be considered to have suggested with respect to the subject matter of the pending claims.

Claim 1 recites, among other features, a catalyst-carried filter comprising a honeycomb structure, and at least one fine coating layer constituted of a porous ceramic ...

wherein a surface of the at least one fine coating layer does not carry the oxidation catalyst thereon. The Office Action and the Advisory Action assert that Hoj can reasonably be considered to teach these features. Applicant respectfully disputes this conclusion for at least the following reason.

Specifically, in affirming the Office Action's rejection of claim 1 over Hoj, the Advisory Action asserts that claim 36 of Hoj discloses forming the filtering walls that contain the catalyst (step (b)), and then drying the filtering walls (step (c)). The Advisory Action further asserts that claim 43, which depends from claim 36, recites adding a membrane without catalytically active material to the surface of the filtering walls. Based on these claims, the Advisory Action summarily concludes that the membrane layer, which is alleged to correspond to the at least one fine coating layer, does not contain any catalytically active material, let alone on the surface. The analysis of the Office Action and the Advisory Action fails for at least the following reasons.

MPEP §2131.01 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Nowhere in claims 36 and 43 does Hoj explicitly teach that the membrane does not carry a catalytic material. In fact, claims 36 and 43 indicate that it may. For example, claim 36 of Hoj recites a method for preparing a filter device that includes producing a filter body comprising at least one porous filtering wall (step (a)), introducing a first slurry or solution containing a catalytically active material into the porous filtering walls (step (b)), and drying the filter body (step (c)). Further, claim 43 recites wherein a membrane forming slurry containing ceramic and/or metallic particles and/or fibres is flowed through the filtering walls to form a membrane layer on or close to a surface of the filtering wall. Importantly, claim 43

does not recite that the membrane layer is added without a catalytically active material provided on the membrane to the surface of the filtering walls. Further, claim 43 does not recite that adding the membrane occurs after step (b) in claim 36. Additionally, claim 44 recites that the membrane-forming slurry is flowed through the filtering wall either after step (a) or (e). As such, claims 36 and 43 at least suggest that the membrane may be coated by a catalytically active material. Thus, the Office Action's and Advisory Action's assertion that claims 36 and 43 teach that the membrane excludes a catalytic material formed thereon is unreasonable.

Since claims 36 and 43 of Hoj do not explicitly teach at least one fine coating layer constituted of a porous ceramic...a surface of the at least one fine coating layer does not carry the oxidation catalyst thereon, in making the rejection, the Office Action must be relying on a theory of inherency. To establish inherency, the Examiner must provide evidence or technical reasoning that makes it clear that the allegedly inherent characteristic must necessarily flow from the teachings of the reference. Based on the features recited in claims 36 and 43 of Hoj, the exclusion of a catalytic material on a surface of the membrane does not necessarily flow and is therefore not an inherent feature. Again, claims 36 and 43 at least suggest that the membrane may have a catalyst formed on its surface.

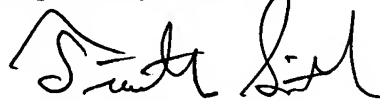
Accordingly, for at least these reasons, Hoj does not explicitly or inherently disclose that the membrane excludes a catalytic material formed thereon. As such, to the extent that the membrane of Hoj can be considered to correspond to the fine coating layer constituted of a porous ceramic, Hoj does not teach, nor would it have suggested, the combination of all of the other features positively recited in independent claim 1. Additionally, claims 2-4 are also neither taught, nor would they have been suggested, by Hoj, even in combination with U.S. Patent No. 5,384,110 to Muramatsu et al. and EP 1018357 A1 to Loncke, which are not

applied in a manner that would overcome of the above-identified shortfalls in the application of Hoj to the subject matter of independent claim 1.

In view of the foregoing, Applicant respectfully requests that the Review Panel review the substance of the August 23, 2007 Final Rejection in light of the above remarks. Applicant believes that upon such review, the Review Panel will determine that the applied reference does not anticipate the subject matter of the pending claims. In this regard, favorable reconsideration and prompt allowance of claims 1-4 are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicant's undersigned representative.

Respectfully submitted,



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Attachment:

Notice of Appeal and Petition for Extension of Time

Date: December 21, 2007

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